

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Duane Le Allen § Group Art Unit: 2126
Serial No.: 08/925,703 §
Filed: September 9, 1997 § Examiner: George L. Opie
For: Method and Apparatus for § Atty. Dkt. No.: MCT-0126-US
Installing an Operating System § (MUEI-0305.00/US)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO OFFICE ACTION DATED MAY 16, 2003

Dear Sir:

In a Final Office Action mailed on May 16, 2003, the Examiner maintains the § 103 rejections of claims 34-51. In this Office Action, the Examiner addresses Applicant's latest reply filed on January 24, 2002. The Examiner's response to this reply is addressed below.

The Examiner contends, "the scope of the claim 'second configuration file' clearly transcends the more narrow scope that Applicant attempts to impute through argument." Final Office Action, 5. The Examiner also reasons, "the Service Pack installs/configures the OS, and it allows 'users to install the latest driver' for new hardware devices." *Id.* However, contrary to the Examiner's position, Applicant has not imputed additional limitations through argument, but rather, Applicant requests the Examiner to consider the specific limitations of the claims, as a *prima facie* case of obviousness requires that "all of the claim limitations must be taught or suggested by the prior art." *In re Royka*, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 165 U.S.P.Q. 494, 496 (CCPA 1970) (stating, "all words in a claim must be considered in judging the patentability of that claim against the prior art"); M.P.E.P. 2143.03.

Date of Deposit: July 16, 2003
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United States Patent and Trademark Office (Fax. No. 703-746-7238) on the date
indicated above.

Janice Munoz

Janice Munoz

Therefore, referring to the specific limitations of the claims, the method of claim 34 recites providing a second configuration file that is external to the operating system package and includes *information to direct the installation of a second driver for a second device*. (emphasis added). Furthermore, the method of claim 34 recites installing the second driver on the computer *based on the information in the second configuration file*. (emphasis added). Likewise, independent claim 44 recites instructions to cause a computer to *generate an external configuration file that is external to an operating system and further recites that the external configuration file includes information to direct the installation of a driver for a particular device*. (emphasis added). Furthermore, independent claim 44 recites instructions to install the driver *based on the information in the external configuration file*.

Considering these specific limitations of claim 34, the Examiner fails to show where any of the cited references (i.e., the Microsoft reference or alleged Applicant's Admitted Prior Art (AAPA)) teaches or suggests a configuration file that includes information to direct the installation of a second driver and installing the second driver based on the information in the second configuration file. The Examiner contends that the Microsoft reference teaches these claim limitations because "second configuration file" is broadly claimed. However, "file" is not taught by the disclosure of a "service pack." Furthermore, claim 34 sets forth additional limitations (emphasized above) that have not been addressed by the Examiner, i.e., the Examiner improperly refers to the Microsoft reference as a whole without addressing the specific limitations of claim 34.

Referring to independent claim 44, none of the cited references teaches or suggests instructions to cause the same computer to generate an external configuration file that is external to an operating system package and install a driver for a particular device of the computer based on the information in the external configuration file. Furthermore, neither reference teaches nor suggests instructions to cause a computer to generate an external configuration file that includes information to direct the installation of a driver for a particular device. Once again, Applicant requests the Examiner to point to the specific language of the Microsoft reference that allegedly teaches or suggests these claim limitations. Otherwise, for at least the reason that the Examiner fails to show where the prior art teaches or suggests the

specific claim limitations of independent claims 34 and 44, a *prima facie* case of obviousness has not been established for either one of these claims.

In response to the lack of a suggestion or motivation to combine references, the Examiner appears to rely on the alleged general level of skill in the art for the combination. Furthermore, the Examiner appears to rely on this general level of skill in the art to fill in the missing claim limitations. However, "obviousness cannot be predicated on what is unknown." Thus, the Examiner must show, with specific citations to a prior art reference, where the prior art contains the alleged suggestion or motivation. *See, Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143. *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Rather, in *In re Fine*, 5 USPQ2d, 1596 (Fed. Cir. 1988), the Federal Circuit held that the Examiner had failed to establish a *prima facie* case of obviousness because of the Examiner's bold assertion that a substitution "would have been within the skill in the art," without offering any support for or explanation of this conclusion. *In re Fine*, 5 USPQ2d at 1599. The Federal Circuit agreed with the appellant that a *prima facie* case of obviousness had not been established and stated, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* 1600. *See also, W.L. Gore & Associates, Inc v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (stating, "to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against his teacher"); *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999) (stating, "rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment").

Claims 35-43 and 45-51 are patentable for at least the reason that these claims depend from an allowable claim.

In response to Applicant's challenge under M.P.E.P. § 2144.03 in connection with the Official Notice taken in the Examiner's last action, the Examiner provided references purporting to teach the additional limitations presented by these dependent claims. However,

obviousness requires more than a mere collection of elements chosen from various prior art references. Rather, obviousness requires a suggestion or motivation to combine the references to derive the claimed invention. M.P.E.P. § 2143. The Examiner fails to show where the prior art teaches or suggests the combination of these references cited by the Examiner. In the brief discussion of these references, the Examiner fails to show where the prior art contains the alleged suggestion or motivation for the combination of these various references with the AAPA and Microsoft reference to derive the claimed invention. Such a suggestion, however, must be present in the prior art to derive a *prima facie* case of obviousness. *See, for example, Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143; *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) (stating, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention"); *See also, W.L. Gore & Associates, Inc v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (stating, " to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against his teacher"); *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999) (stating, " rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment").

To the extent that the Examiner is relying on the alleged general level of skill in the art to supply the alleged suggestion or motivation, Applicant maintains the challenge pursuant to M.P.E.P. 2144.03 for the Examiner to show a prior art reference that contains the alleged suggestion or motivation for the combination/modification set forth by the Examiner. Otherwise, for at least these additional reasons, withdrawal of the § 103 rejections of the dependent claims is requested.